

REMARKS

Claims 9 and 15 are cancelled with this amendment. The amendments do not constitute the addition of new matter and cancelation of claims 9 and 15 clearly simplify issues for Appeal. Accordingly, Applicant respectfully requests the entry of the amendment.

Regarding the rejection of the remaining claims as obvious, the cited reference (Ishida) was previously applied and successfully rebutted as discussed below. Reconsideration of the application in view of the amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph – written description

Claims 9 and 15 are rejected under 35 U.S.C. § 112, first paragraph as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time that the application was filed.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 9 and 15 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Without conceding to the Examiner's position with regards to the above rejections under 35 U.S.C. § 112, 1st and 2nd paragraph, claims 9 and 15 have been canceled. Accordingly, these grounds of rejection are moot.

Rejection under 35 U.S.C. § 103(a)

Claims 7, 9, and 12-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida, et al. (EP 1147764).

The Office Action states that this is a new ground of rejection necessitated by amendment. However, Applicants respectfully point out that Ishida, et al. was previously applied in the Office Action of July 31, 2008 and successfully rebutted with the response of April 22, 2009, filed as an RCE on May 11, 2009. The response was accompanied by the 132 Declaration

of Akihiro Tada. Applicants respectfully request consideration of these previously submitted arguments and 132 Declaration as they apply to the present claims and issues raised by the Examiner.

The Office Action points out that the claimed compound (Centaureidin) differs from Ishida, et al. in having 3 methoxy groups while Ishida, et al. teach "at least four methoxy groups (see page 3, line 18)" (Office Action, page 6, paragraph 2). The Office Action states that "it is expected that compounds of general structure I taught by Ishida et al. and Centaureidin of the instant application, differing by only one -CH₃ group, would have similar chemical physical and biochemical properties" (Office Action, page 7, end of 1st paragraph; also page 8, paragraph 3; also page 11, end of paragraph 1).

Despite this structural similarity, Centaureidin has a very different action compared to the compounds of Ishida. As shown in Table 1 of Ishida, et al. on page 8, some of the compounds of Ishida, et al., including Compound III which is used in Examples 1, 3-5, and 7-11 of Ishida, et al., inhibit melanin production. However, Ishida, et al. does not teach any compound that inhibits length of dendrites.

As shown in the previously submitted Declaration of Akihiro Tada (Tada Declaration), Nobiletin, which corresponds to Compound III of Ishida, et al. and is used in Examples 1, 3-5, and 7-11 of Ishida, et al., has no significant effect on dendrite length over a concentration range of 10⁻⁶ % to 10⁻⁴ %. In contrast, centaureidin, according to the claimed invention, has a dramatic inhibitory effect on dendrite length. In view of the structural similarity between centaureidin according to the claimed invention and compound III of Ishida, et al., this dramatically different effect was unexpected. This is directly contrary to the expectations expressed in the Office Action that compounds of similar structure, would have similar chemical physical and biochemical properties. The Office Action at least implicitly admits that the effects demonstrated by the claimed invention were unexpected.

The Office Action states that "products of identical or similar composition cannot exert mutually exclusive properties when administered under the same circumstance" (Office Action, page 8, paragraph 2; also page 12, paragraph 2). In response, neither Centaureidin (according to the claimed invention) nor Nobiletin (according to Ishida) are capable of whitening skin of all types. Centaureidin is effective to inhibit dendrite lengthening, but not particularly effective to

inhibit melanin production (see RCE response of May 11, 2009) while Nobiletin is not effective to inhibit dendrite elongation but is effective in inhibition of melanin production (see Table 1 of Ishida and Tada Declaration).

The Office Action states that “the discovery of a previously unappreciated property of a prior art composition or a scientific explanation for the prior art’s functioning does not render the old composition patentably new to the discover (Office Action, page 8, paragraph 2, citing M.P.E.P. 2112; also page 12, paragraph 2). However, such is not the case here. Centaureidin is *chemically distinct* from the compounds taught by Ishida, et al. and has *different properties and function*.

Centaureidin has the remarkable effect of inhibiting dendrite length. This effect is important for a subject whose pigmentation is caused not only by production of melanin, but also by elongation of melanocytic dendrites. The compounds of Ishida, et al. are not effective to inhibit dendrite length and so would have minimal effect to whiten skin in the case where pigmentation is caused by elongation of melanocytic dendrites.

The Examiner discounts the phrase “whereby elongation of melanocytic dendrites is inhibited” as merely the intended result of the process steps positively recited (Office Action, page 7, last paragraph; also page 11, last paragraph). However, in M.P.E.P. 2111.04 cited by the Examiner it also states that “when a ‘whereby’ clause states a condition that is material to patentability; it cannot be ignored in order to change the substance of the invention”. In the present case, the cited reference, Ishida, et al. do not show inhibition of elongation of melanocytic dendrites as shown by the Tada Declaration. It is improper to ignore the evidence presented by Applicants by 132 Declaration. Centaureidin is a chemically different compound that acts in a different way to whiten skin compared to the teaching of Ishida, et al. Accordingly, if dark complexion is caused by both melanin production and elongation of melanocytic dendrites, then application of centaureidin according to the claimed invention will further whiten skin even after treatment with compounds according to Ishida, et al. The “substance of the invention” is that the claimed method of Applicants is effective even under circumstances when the compounds of Ishida, et al. are ineffective.

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In particular, claims 14-17 relate to treatment of dyschromatosis. The compounds of Ishida, et al. will have minimal effect on dyschromatosis as the compounds of Ishida, et al. do not inhibit dendrite length as demonstrated by the 132 Declaration of Akihiro Tada, discussed above.

The Office Action states that "the prior art establishes that both [centaureidin and compounds of Ishida, et al] function in similar manner" (Office Action, page 12, last paragraph). However, as discussed above, the compounds of Ishida, et al. and the claimed compound, centaureidin, function in a completely different manner such that one may be effective where another is not or the use of the two together may be more effective than the use of either one by itself. The two compounds are not interchangeable with respect to effect.

In view of Applicants' arguments, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Co-pending applications

Applicants would like to bring U.S. Application No. 10/580,992 (US Publ no. 2007/0105947) to the Examiner's attention. Although Appl. No. 10/580,992 is not believed to be prior art due to its later filing date, there is overlap in inventive entity between the present application and U.S. Application No. 10/580,882.

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CONCLUSION

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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